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REMARKS

The present response is filed with a Request for Continued Examination (RCE) and is to the Office Action mailed in the above-referenced case on November 21, 2003, made Final. Claims 8-25 are presented for examination. The Examiner has objected to the drawings and specification due to informalities. Claims 8, 10 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 8-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikkola et al. (6,529,143), hereinafter Mikkola, in view of Tso (U.S. 6,047,327), hereinafter Tso.

Regarding the Examiner's objection to the drawings and specification, and the 112 rejection of claims 8, 10 and 19 due to informalities, applicant herein amends the language of the specification to clarify the language, and amends the language of the claims to correct the antecedent basis. In the matter of the objection to the drawings, applicant respectfully traverses the Examiner's requirement for a drawing change. The name given to server 13 as a "geographic information server" is a descriptive name which stands as a part of the original disclosure in the present case. In the text this server is referred to as a server and an Internet-connected server, which descriptions are not at all conflicting with the name used in the drawings, and should cause no confusion to the skilled artisan. The applicant respectfully requests that the objection to the drawings be withdrawn.

Applicant has carefully studied the prior art presented by the Examiner and the Examiner's rejections and statements of the instant Office Action. In response applicant herein amends the claims to more particularly point out and distinctly claim the subject matter of applicant invention regarded as patentable. Applicant points out and argues the limitations of applicant's

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claims as amended, which distinguish clearly and unarguably over the prior art cited and applied by the Examiner.

Regarding claim 8, the Examiner has stated that Mikkola discloses an information system for delivering position-related information to a portable digital appliance, comprising substantially the limitations of applicant's claims, with the exception that Mikkola does not specifically disclose a client profile recording specific references for a user of the digital appliance. The Examiner has relied on Tso for teaching this deficiency, stating that the reference teaches, in the same field of mobile information retrieval endeavor, storing and maintaining a client profile with specific preferences for a user, and that it would have been obvious to combining the teachings to produce applicant's invention.

To clearly distinguish applicant's claims over the combined teachings cited and applied by the Examiner, applicant herein amends the language of the base claims to specifically recite wherein the information system selects information to be provided to the appliance according to the position of the appliance, change of position of the appliance relative to time, and user preference indicated in the client profile, and stores a record of user locations and activities.

Applicant's invention teaches that the information server, in response to receiving the information request, either automatic or user-initiated, updates the dynamic location of the user/device, as well as updating other statistical and historic data, and then stores all of the necessary data. This action continues in a session to develop and store a complete record of user/device locations, static and dynamic, and all activities of the user/device. The process continues throughout a client session, with more requests to the server, and more data accesses and deliveries to the user/device. At any point in time, then, the system knows the precise location of the user/device, all of the

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previous locations and activities, providing a track record including direction and rate, and can make future predictions as well, based on past movement. There may be included an interface for a client to, for example, retrace the history of a session, and so on.

In an example wherein a user, having the digital appliance temporarily issued to the user by a worker at a site of interest, a museum for instance, may be taking a walking tour of the site including exhibits, the server accesses appropriate information about exhibits based on location and activities of the user/device, and sends that information along to the device. When the user is finished with the tour and turns in the temporary digital device, all of the locations and activities of the user during the tour are recorded and stored in the data repository. The exhibit worker at the site may then be enabled to cause a document to be printed describing the user's tour, as a souvenir. This document may include boilerplate elements about specific exhibits, which may be organized and presented according to the session history, i.e. activities of the user.

The reference of Mikkola teaches retrieving point of interest information in accordance to the interest of the user. The Examiner has admitted, however, that Mikkola fails to specifically disclose a client profile recording specific preferences for the user of the digital appliance. Applicant points out that Mikkola also fails to teach recording and storing in the data repository, the historic activities of the user.

The Examiner has relied on the reference of Tso for teaching storing and maintaining a client profile with specific preferences for user (col. 4, lines 34-53, col. 10, lines 41-61 and col. 15, lines 41-51). Applicant has carefully studied the portions cited and applied by the Examiner, as well as all of the remaining portions of the disclosure, and applicant can nowhere find any teaching or suggestion in Tso of recording, developing and storing a complete

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record of user locations, static and dynamic, and all user activities, as is taught in applicant's invention and recited in applicant's base claims as amended. Tso simply records and stores as a client profile, specific user preferences provided by the user of the digital appliance, and other client related information such as gender, income, interests, and other demographic information, but makes no historical record of the user's activities, as described above for applicant's invention.

The combined teachings of Mikkola and Tso provide an information system that knows, at any given time, the current position, direction of movement, and so on, of the user/device, but the system of the combined teachings clearly has not the capability of knowing, at any point in time, all of the previous locations and activities of the user/device, providing a track record including direction and rate, and therefore the capability of making future predictions of user/device activity, or providing historic reports to the user/device, based on past historical movements and activities of the user/device.

Applicant therefore believes that independent claim 8 as amended to recite storing a record of such user locations and activities, is now clearly and unarguably patentable over the combined teachings. Depending claims 9-16 are then patentable on their own merits, or at least a depended from the patentable claim.

Applicant's claim 17 recites the method of applicant's invention for delivering position-related information to the portable digital appliance, in accordance with applicant's claims 8. The Examiner has rejected claim 17 and the depending claims for the same reasons set forth in the rejection of claims 8-16. Applicant has accordingly herein amended the language of claim 17 to include a step for storing the record of appliance locations and activities. Applicant's claim 17 as amended is therefore now also clearly and unarguably

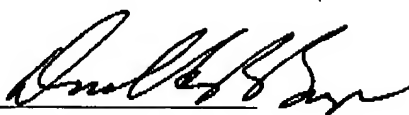
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patentable over the combined teachings of the prior art presented by the Examiner. Depending claims 18-25 are then also patentable on their own merits, or at least as depended from a patentable claim.

Applicant therefore respectfully requests that the present case be reconsidered and passed quickly to issue. If there are any time extensions due beyond any extension requested and paid with this amendment, such extensions are hereby requested. If there are any fees due beyond any fees paid with the present amendment, such fees are authorized to be deducted from deposit account 50-0534.

Respectfully Submitted,
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Please find below and/or attached an Office communication concerning this application or proceeding.

Non Compliant



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Paper No. 9

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 2/3/04 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted. 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____
- ☐ 3. Amendments to the drawings: _____
- ☒ 4. Amendments to the claims:
- ☒ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims).
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: _____

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preopnotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given **ONE MONTH** from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH** time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a **TIME PERIOD** of **ONE MONTH** from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

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Rev. 10/03